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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,045	12/18/2000	Jacques Bauer	GEI-084	6820

20311 7590 09/02/2004

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EXAMINER

RUSSEL, JEFFREY E

ART UNIT	PAPER NUMBER
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1654

DATE MAILED: 09/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/720,045

Applicant(s)

BAUER ET AL.

Examiner

Jeffrey E. Russel

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1654

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08/18/04 and 8/27/04 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: 5-8.

Claim(s) rejected: 4 and 16-31.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

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1. The proposed amendment filed August 18, 2004 will not be entered because of word-processing errors at page 6 of the amendment. Applicants re-submitted the amendment on August 27, 2004.

The proposed amendment filed August 27, 2004 will not be entered because the amendment is not in proper format under 37 CFR 1.121. Firstly, the proposed amendments to both the specification and the claims appear to be based upon the specification and claim amendments contained in the proposed amendment filed July 14, 2004. However, this amendment was not entered, and will not be entered even upon the filing of a Notice of Appeal. The markings for any amendments must be based upon the specification and claims at the time of the final Office action. Secondly, Applicants appear to use brackets to show deletions of chemical formulas from claims 16, 21, 23, 32, and 33. However, 37 CFR 1.121(c)(2) requires that strikethrough be used to show deletions from the text of a claim. Thirdly, the status identifier used for claim 19, "currently presented", is not permitted by 37 CFR 1.121(c).

2. There was no response to the requirement set forth in section 2 of the final Office action.

3. The proposed new Brief Description of the Drawings filed August 27, 2004 raises the same new matter issue as is set forth in the Advisory action mailed July 27, 2004, section 3.

4. With respect to section 5 of the final Office action, there was no response to the objection to claim 17, line 1, concerning "compositions", and there was no response to the objection to claim 23, line 4, concerning the comma after "atoms".

5. In addition to those objections and rejections which would have remained from the final Office action, Applicants' proposed amendments to the claims filed August 27, 2004 raise the following new issues: At proposed claim 16, page 6, line 3, "several" should be deleted. At

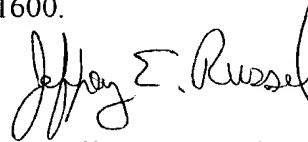
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proposed claim 21, page 8, line 8, “dihydroxyphosphoryloxy” should be changed back to “dihydroxyphosphonyloxy”. At proposed claim 21, page 8, line 9, “dimethoxyphosphoryl” should be changed back to “dimethoxyphosphonyl”. There is no support for the new substituent listed at proposed claim 21, page 8, line 13. The limitation “in need of an immune response” at proposed claim 31, lines 2-3, raises new issues requiring further consideration and/or search, it being much narrower in scope than the previous limitation “in need of immune modulation”. Proposed claim 32 raises issues under 35 U.S.C. 112, second paragraph, because it purports to be drawn to a method of obtaining a compound of formula I according to claim 21, but formula I in claim 32 is defined differently than formula I in claim 21. At proposed claim 32, “dihydroxyphosphoryloxy” should be changed back to “dihydroxyphosphonyloxy” and “dimethoxyphosphoryl” should be changed back to “dimethoxyphosphonyl”. There is no support for the new substituent listed at proposed claim 32, page 12, line 7. Proposed claim 32 is indefinite because there is no “q+1” position in the diamino acid. In proposed claim 32, page 13, lines 1 and 8-9 should be omitted as being redundant. Proposed claim 33 raises the same new issues as does proposed claim 32. At proposed claim 33, page 17, line 7, “integer” is misspelled.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey E. Russel at telephone number (571) 272-0969. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Bruce Campell can be reached at (571) 272-0974. The fax number for formal communications to be entered into the record is (703) 872-9306; for informal communications such as proposed amendments, the fax number (571) 273-0969 can be used. The telephone number for the Technology Center 1600 receptionist is (571) 272-1600.

A handwritten signature in black ink, appearing to read "Jeffrey E. Russel". The signature is fluid and cursive, with the first name "Jeffrey" and last name "Russel" clearly distinguishable.

Jeffrey E. Russel

Primary Patent Examiner

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JRussel

August 31, 2004